

REMARKS

Claims 8, 9, 12, 13, 19-46 and 49-65 were pending in the present application prior to the instant Amendment, of which claims 8, 9, 12, 13, 25 and 26 were withdrawn from consideration. With the instant Amendment, claims 30, 31, 32, 37-39, 41, 44 and 46 are amended for purposes of clarity. Upon entry of this Amendment, claims 8, 9, 12, 13, 19-46 and 49-65 will be pending and under consideration.

I. Amendments to the Claims

Claims 30, 31, 32, 37-39, 41, 44 and 46 have been amended without altering their scope to correct a grammatical error. Applicants submit that the amendments to the claims are fully supported by the specification as originally filed and present no new matter. Entry thereof is respectfully requested.

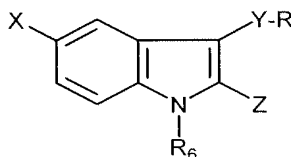
II. Rejection of Claims 19-24, 27-46 and 49-56 Under 35 U.S.C. § 102(b)

Claims 19-24, 27-46 and 49-56 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Williams *et al.*, European Patent No. 0530907 (“the ’907 EP patent”). *See* Office Action, p. 3. Applicants respectfully traverse the rejection.

“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *See In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir., 1990). Anticipation is not shown even when the differences between the claims and the cited reference are allegedly “insubstantial” and any missing elements could be supplied by the knowledge of one skilled in the art. *See Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir., 1984). Furthermore, in *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 U.S.P.Q. 253, 259 (Fed. Cir., 1985), the Federal Circuit explained that “a reference which does not satisfy one limitation of a claim does not anticipate.” Thus, a cited reference must describe each and every claim limitation in order to anticipate the invention as claimed.

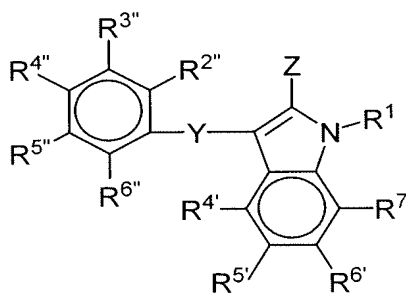
Applicants respectfully submit that the ’907 EP patent does not teach each and every limitation of claims 19-24, 27-46 and 49-56.

The ’907 EP patent purportedly discloses inhibitors of HIV reverse transcriptase which are indole compounds of formula A:



wherein X is -H, -Cl, -F, -Br, -NO₂, -CN or -OR₂; and wherein the other variables are as defined in the '907 EP patent. *See* the '907 EP patent, p. 3., ll. 1-12.

Claims 19-24, 27-46 and 49-56 recite methods comprising administration of a compound of formula (I):



Instant claims 19, 20, 23, 24, 27 and 28 further recite “R^{4'}, R^{5'}, R^{6'}, [and] R^{7'} ... are each independently H; halo; -NO₂; -CN; -OH; -OR²; ... wherein at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} are not hydrogen.” Amended claim 31 further recites “R^{4'}, R^{5'}, [and] R^{7'} ... are each independently H; halo; -NO₂; -CN; -OH; -OR²; ... wherein at least two of R^{4'}, R^{6'} or R^{7'} are not hydrogen. Amended claims 30 and 32 further recite “R^{4'}, R^{5'}, R^{6'}, [and] R^{7'} ... are each independently H; halo; -NO₂; -CN; -OH; -OR²; ... wherein at least two of R^{4'}, R^{6'} or R^{7'} are not hydrogen. Instant claims 33-36, 40, 42 and 43 and amended claims 37-39, 41, 44 and 46 further recite “R^{4'}, R^{5'}, R^{6'}, R^{7'} are each independently H or halo ... wherein at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} are not hydrogen.” The remaining rejected claims depend from and incorporate the above-described limitations of claims 19, 20, 23, 24, 27 and 28, 31-44 and 46. Accordingly, in the compounds administered in the claimed methods, at least two of R^{4'}, R^{5'}, R^{6'}, R^{7'} are not hydrogen (*i.e.*, there are at least two substituents on the phenyl ring of the indole, at the 4-, 5-, 6- or 7-positions).

The '907 EP patent does not teach or suggest methods comprising administration of compounds of formula (I) wherein there are at least two substituents on the phenyl ring of the indole, at the 4-, 5-, 6- or 7-positions. Instead, the indole compounds disclosed in the '907 EP patent are either unsubstituted or mono-substituted at the 5-position on the phenyl ring of the indole. As such, the '907 EP patent does not teach the compounds or substitution pattern of Formula (I) of claims 19-24 and 27-46 and 49-56.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 19-24, 27-46 and 49-56 under 35 U.S.C. § 102(b) in view of European Patent No. 0530907. Further, Applicants respectfully submit that in a previous Office Action, the Patent Office rejected claims under 35 U.S.C. § 103(a) in view of Williams *et al.*, U.S. Patent No. 5,527,819 (“the ’819 patent”). Applicants note that the ’907 EP patent and the ’819 patent both claim priority to U.S. Patent Application Nos. 07/756,013, 07/832,260, and 07/866,765.

Applicants respectfully submit that the the ’907 EP patent does not provide a reason why one of ordinary skill in the art would modify the compounds described by the ’907 EP patent to arrive at the compounds of the instant claims. In particular, the ’907 EP patent does not provide a reason why one of ordinary skill in the art would substitute at least one hydrogen at the 4-, 6- or 7-positions of the phenyl ring of the unsubstituted or mono-substituted indole compounds of the ’907 EP patent with one of the substituents recited in, for example, instant claim 19. Accordingly, the claims would not be obvious over the ’907 EP patent.

III. Allowable Subject Matter

The Examiner objects to claim 57 as being dependent upon a rejected base claim, but notes that claim 57 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 57 is dependent of claims 19-24. Applicants submit that the arguments presented hereinabove overcome the rejection of base claims 19-24. Hence, Applicants respectfully request the objection be withdrawn.

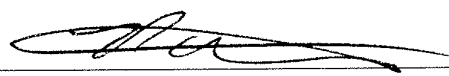
CONCLUSION

In the light of the above remarks, Applicants respectfully request that the Patent Office reconsider this application with a view towards allowance.

No fee other than the fee for an extension of time and for the submission of an Information Disclosure Statement is believed to be due with this paper. However, the Commissioner is hereby authorized to charge any required fee to Jones Day Deposit Account No. 50-3013 (order no. 417451-999076).

Respectfully submitted,

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Rahul Pathak

42,983

(Reg. No.)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939